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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,364	09/06/2005	Dietmar Pennig	7202-78	3372
30448	7590	12/24/2008		
AKERMAN SENTERFITT			EXAMINER	
P.O. BOX 3188			WOODALL, NICHOLAS W	
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		ART UNIT	PAPER NUMBER	
		3775		
MAIL DATE		DELIVERY MODE		
12/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/526,364

**Applicant(s)**

PENNIG, DIETMAR

**Examiner**

Nicholas Woodall

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-7,9-12,14 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9-12,14 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's amendment received on 09/17/2008.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-7, 9-12, 14, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow (U.S. Publication 2003/0135212) in view of Wagner (U.S. Publication 2004/0181228).

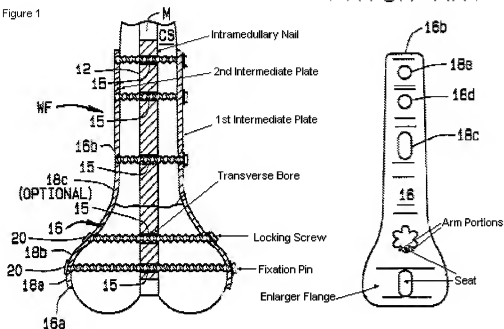
Chow discloses a device comprising at least one humeral nail, at least one fragment fixation pin, and at least one rounded intermediate plate element (see Figure 1 below). The humeral nail includes at least one transverse hole that allows the passage of a locking screw that includes a screw head and a screw body. The at least one intermediate plate comprises an enlarged flange portion and two arm portions extending from the flange portion to define a longitudinal direction, wherein the intermediate plate is placed between the screw head of the locking screw and the surface of the bone such the screw head abuts the intermediate plate. The intermediate plate is slightly curved in the longitudinal direction to allow the plate to conform to the surface of the bone. The two arm portions can be positioned astride the screw body of the locking screw prior to the final fastening of the locking screw head and present rounded ends. The fragment fixation pin includes a final threaded portion having a diameter smaller than the

diameter of the seat, wherein the fixation pin is passed through a seat in the enlarged flange portion of the intermediate plate element and is inserted into the bone. The seat includes at least one hole in the enlarged flange portion and at least one hole formed in the elongated arms portions. The device further comprises a second intermediate plate inserted between the screw head of a second locking screw and the surface of the bone. The transverse hole of the nail includes at least a couple of opposite holes that define the transverse hole. Chow discloses a method of using the device as described above wherein the device can be used in any area of the body, i.e. the humerus. Therefore, Chow discloses a method of using the device on the humeral bone. Chow fails to disclose the device wherein the transverse bore includes an internal partially threaded portion, the second intermediate plate element being larger than the first intermediate plate element, and the arm portions of the intermediate plate element being larger than the arm portions of the first intermediate plate portion. Wagner teaches a device including a transverse bore including an internal partially threaded portion, wherein the portion nearest the screw head includes the partial threading in order to engage and fix a threaded bone screw with respect to the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Chow wherein the transverse bore includes an internal partially threaded portion in view of Wagner in order to engage and fix a threaded bone screw with respect to the device.

Regarding the second intermediate plate element being larger than the first intermediate plate element and the arm portions of the second intermediate plate

element being larger than the arm portions of the first intermediate plate element, it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Chow wherein the second intermediate plate element is larger than the first intermediate plate element and wherein the arm portion of the second intermediate plate element are larger than the arm portions of the first intermediate plate portion because the prior art device does not perform differently than the current invention as claimed. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984).

Figure 1



### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 3, 5-7, 9-12, 14, and 23-25 have been considered but are moot in view of the new ground(s) of rejection. The examiner has provided new grounds of rejection as necessitated by the amendment making this office action **FINAL**.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3775  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733